

REMARKS

Applicant's attorney wishes to thank the Examiner for the careful consideration given this case, for which Claims 1, 3-5 and 8-17 are pending. This response addresses those issues raised in the Office Action mailed February 19, 2003. In view of the following remarks, Applicant believes the present application is in condition for final allowance, and an indication to that effect is respectfully requested.

Claim 1 has been amended to clarify the invention. No new matter is added.

35 U.S.C. 112 First Paragraph:

Claims 1-5 and 8-17 were rejected under 35 U.S.C. §112 as containing "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Specifically, the Examiner stated that "[t]he specification as originally filed does not teach that the interpenetration of the fibers forms pores."

As pointed out by the Applicants in its response to the Office Action dated June 10, 2002, the specification not only teaches that the interpenetration of the fibers forms pores, but does so quite clearly. Notwithstanding, without conceding the validity of the Examiner's rejection and to solely to expedite the prosecution of this application, Applicants have elected to revise claim 1. Accordingly, Applicants believe that the entry of this amendment should overcome the rejection under 35 U.S.C §112, first paragraph.

35 U.S.C. § 103(a)

The Examiner rejects Claims 1, 3-5, 10 and 16-17 under 35 U.S.C. § 103(a) as being unpatentable over JP 07-125128 A to So et al in view of WO 96/19599 to Lorcks et al (equivalent to U.S. Patent No. 6,218,321). Applicant respectfully traverses this rejection.

The Examiner restates the earlier basis for rejection as to the preamble, i.e., that it is not entitled to patentable weight because it merely recites the intended use of a structure, and cites *In re Hirao*, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). First, Applicant respectfully points out that no litmus test defines as to when a preamble limits claim scope (See, *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 9 USPQ 2d 1962, (Fed. Cir. 1989); the general rule, however, is that a preamble limits the claimed invention if it recites essential structure or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 51 USPQ 2d 1161 (Fed. Cir. 1999). Further, whether to treat a preamble as a limitation should be determined only after gaining "an understanding of what the inventors actually invented and intended to encompass by the claim." *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 62 USPQ 2d 1781 (Fed. Cir. 2002). Furthermore, the cases cited by the Examiner supports the Applicants', not the Examiner's position.¹

In the present case the very first sentence in the specification begins with a term "[t]his invention relates to a filter material". See, the specification page 1, line 3. See also, for example, the specification page 2, lines 11, 22 and 27. The specification, therefore, indicates that the inventors believed their invention to be a "... filter material", a term expressed in the preamble. As required by the above case law, the meaning of the preamble in the present case must be taken from the specification (*Kropa*) and the interpretation of the preamble should not improperly *broaden* the scope of the claim (*Hirao*). Accordingly, the Examiner's refusal to accord patentable weight to the recitation ("multi-ply filter material") is improper under the case law.

¹ In *Hirao*, the court found the preamble to be merely reciting the intended purpose as any other interpretation of "the preamble would improperly *broaden* the scope of the claim." In *Kropa*, the court stated that "the meaning [of the term used in the preamble] must be taken from the application.

As to Lorcks, the secondary reference, the Examiner continues to assert that this reference “teaches at col. 7, lines 54 – col. 8, line 45 and col. 8, line 66 – col. 9, line 13, that fabrics comprising both biodegradable polymers and natural fibers can be formed into a variety of materials . . . Therefore, Lorcks et al teaches that the type of fabric disclosed in So et al is also suitable for use for making porous or preamble materials. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed material of So et al., so that it comprised pores.” Applicant disagrees.

First, Applicant maintains its arguments, related to Lorcks reference, in its response to the Office Action dated June 10, 2002. Further, Lorcks does not teach or suggest any multi-ply material, much less a multi-ply material as required by the claim 1. Furthermore, Lorcks does not teach even fabrics comprising both biodegradable polymers and natural fibers either in the text cited by the Examiner or elsewhere in the reference. Applicant notes that Lorcks teaches synthetic fibers and thermoplastic polymers but neither the term “natural fiber(s)” nor an example of a natural fiber appears in the Lorcks reference. The Examiner has not pointed to any such teachings.

Assuming for the sake of argument that Lorcks does teach fabrics comprising both biodegradable polymers and natural fibers as asserted by the Examiner, this teaching, i.e., a ply comprising both biodegradable polymers and natural fibers, stands in stark contrast to that of So reference. The So reference, according to the Examiner, “discloses a material comprising a first ply of natural fibers and a second ply of biodegradable fibers such as aliphatic polyesters.” Thus, the asserted combination of references cannot be combined. Even if combined it would require a substantial reconstruction and redesign of the elements disclosed in the So reference. Furthermore, there is no reasonable expectation of success in making the claimed material based on the cited references. *See In re Vaack*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure. *Id*; *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998). The Examiner has established none.

Therefore, the teachings of So and Lorcks references are not sufficient to render the claims *prima facie* obvious.

Assuming for the sake of argument that Lorcks is properly combinable with So, neither So nor Lorcks teach or suggest other limitations such as, for example, "said ply containing natural fibers and said ply containing biodegradable, thermoplastic fibers are connected by interpenetration of said thermoplastic fibers and said natural fibers." To establish *prima facie* case of obviousness of a claim, all the claim limitations must be suggested by the prior art. *In re Ochiai*, 37 USPQ 2d 1127 (Fed. Cir., 1995).

Accordingly, Applicants respectfully submits that the Examiner has not established a *prima facie* case of obviousness of claim 1 under 35 U.S.C. § 103(a). Even if *prima facie* obviousness has been established, which it has not, it is urged that the cited art nonetheless fails to render the present invention obvious under a proper § 103 analysis, as the proper suggestions or motivations and reasonable expectation of success to combine the cited references are lacking. In view of the foregoing, dependent claims, 3-5, 10 and 16-17 are considered by Applicant to define patentable subject matter. Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner also rejects claims 8-9 and 11-15 under 35 U.S.C. § 103(a) as being unpatentable over So et al. and Lorcks et al. in view of Pophusen et al., U.S. Patent No. 5,928,739. Applicant respectfully traverses this rejection.

The Examiner avers that Pophusen is relied on for the specifics regarding the biodegradable fibers set forth in claims 8-9 and 11-15, which are not taught in So and Lorcks references. Assuming for the sake of argument that Pophusen teaches biodegradable fibers set forth in claims 8-9 and 11-15, this reference, however, does not cure the deficiencies in So and Lorcks combination. As discussed above, the Examiner has not established a *prima facie* case of obviousness of claim 1 based on So and Lorcks references. Therefore, there is no teaching, suggestion, or motivation provided in the combination of So, Lorcks and Pophusen references to arrive at the invention set

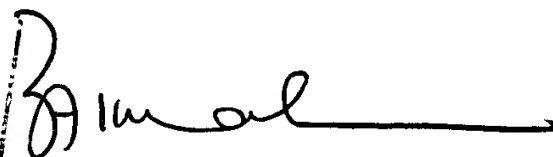
forth in claims 8-9 and 11-15. Accordingly, dependent claims, 8-9 and 11-15 are considered by Applicants to define patentable subject matter.

Furthermore, Applicants note that the Pophusen patent was issued on July 27, 1999, which is after the effective filing date, i.e., April 30, 1998, of the above application. Pursuant to MPEP § 706.02(b), however, such a reference can be disqualified as a prior art reference as long as the foreign priority filing antedates Pophusen patent (e.g., July 10, 1997) and the foreign priority is perfected. The present case meets these two requirements and therefore, Pophusen cannot be considered to be a proper prior art reference. Accordingly rejection of claims 8-9 and 11-15 under 35 U.S.C. §103(a) is inappropriate. Reconsideration and withdrawal of this rejection are respectfully requested.

In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance and notice to such effect is requested. If the Examiner believes that additional issues need to be resolved before this application can be passed to issue, the undersigned invites the Examiner to contact him at the telephone number provided below.

Respectfully submitted,

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Nanda P.B.A. Kumar
Registration No. 44,853
for
Marc J. Farrell
Reg. No. 37,826

REED SMITH LLP
P.O. Box 488
213 Market Street, 9th Floor
P.O. Box 11844
Harrisburg, PA 17108-1844
(717) 257-3044
mfarrell@reedsmith.com

Attorneys for Applicants